

Application No. 10/034,238
Amendment "E" dated May 14, 2008
Reply to Office Action mailed November 14, 2007

REMARKS

The Office Action, mailed November 14, 2007, considered claims 1-21 and rejected claims 1-7, 9-17 and 19-21. Claims 1-6, 9-16 and 19-21 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Chang* (U.S. Patent No. 6,223,028). Claims 7 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chang* in view of *Harrenstien* (U.S. Patent No. 7,085,553). Claims 8 and 18 were objected to as being dependent upon a rejected base claim, but would be allowed if rewritten in independent form including all of the limitations of the base claim and any intervening claims.¹

By this amendment, claims 1, 8, 9 and 12 and 18 are amended, claim 22 is added, and claim 19 is cancelled. Accordingly, following this paper, claims 1-18, 20-22 remain pending, of which claims 1, 10, 11, 12, 20 and 21 are the only independent claims at issue.

Applicant's claims are directed to a messaging system in which the content of a message transmitted to a mobile device is dependent on the radio transferring capabilities of the mobile device, and which allows the mobile device to initiate transfer of the radio transferring capabilities over a packet data session established by the wireless communication station. For example, as recited in claim 1, a server transmits a request to a wireless communication station. In the request, the wireless communication station is asked to identify its radio transferring capabilities and to respond to the server with such capabilities, and the server provides its own packet data network address. The server then receives the response from the wireless communication station, in which the radio transferring capabilities of the wireless station are identified. The response itself is received as packet data over a packet data session that was established by the wireless communication station using the packet data network address of the server as included in the request. Based on those capabilities that are included in the response, the content of a message is adapted.

Claims 10 and 11 recite a computer-readable storage medium and server, respectively, capable causing performance of a method generally corresponding to the method of claim 1. Claims 12, 20 and 21 recite a method, computer-readable storage media, and wireless

¹ Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

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communication station, which incorporate similar functionality, but are recited from the perspective of the mobile station.

1. Substantive Rejections

While *Chang* generally disclose a messaging system in which a server sends a message to a mobile client station before sending the message, it fails to disclose or suggest the claimed invention. For example, among other things, the cited reference fails to disclose or suggest a system in which the wireless station is, in a request for identification of its own radio transferring capabilities, provided with the address of the requestor for a packet data session, and/or in which that address is then used by the wireless station to establish a packet data session and transmit a response to the request, as claimed in combination with the other claim elements. This is particularly so when considering that the server may be unaware of the packet data network address of the wireless station (claim 9), and/or in which the original request is in an SMS message, while the response is over the packet data session. Indeed, *Chang* merely discloses an over-the-air-function (OTAF) for programming a wireless phone in which a request for protocol capability requests are received, and responses are sent between the phone and the OTAF. Not use of a packet data session, or even the inclusion of a packet data network address of a server or wireless device, are disclosed.

More particularly, *Chang* discloses that a mobile phone within a telephone network may be programmed by the OTAF using base transceiver stations (BTS). (Col. 4, ll. 23-30). Before programming occurs, the OTAF sends a request to the mobile, via the BTS, for the mobile's protocol capabilities. The mobile then responses with the protocol capability message. (Col. 4, ll. 30-35). The list of parameters that may be included in the response can include:

- A message type indicator (OTASP_MSG_TYPE);
- A version of the firmware of the mobile (MOB_FIRM_REV);
- Phone model number (MOB_MODEL);
- Number of features supported by the phone (NUM_FEATURES);
 - Each feature has its identification number (FEATURE_ID); and
 - Each feature includes a feature protocol version (FEATURE_P_RFV);
- Over the air capabilities of the phone; (BAND_MODE_CAP);
- Number of service options supported by the phone (NUM_SO); and

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- Identification of the service option to be used (SERVICE_OPTION).

(Col. 4, ln. 34 to Col. 7, ln. 20). Using the information provided in this response, the requestor can then program the mobile telephone over the air. (Col. 7, ll. 20-25).

Accordingly, while *Chang* discloses a system for sending a request for capabilities and receiving a response therefrom, *Chang* fails to disclose any system in which an address of the requestor is provided, let alone a packet data network address of the server as recited in combination with the other claim elements. Indeed, the Office Action acknowledges that previously presented claims 8 and 18 were allowable over the art of record, which claims included, at least in part, the server sending its packet data network address to the mobile device for the mobile device to then establish a packet data session, as recited in combination with the other claim elements.

Applicant respectfully submits that *Harrenstien*, whether cited alone or in combination with *Chang* also fails to remedy the aforementioned deficiencies. For example, *Harrenstien* discloses that information intended for the client is received or generated by the server. (Col. 5, ll. 19-20). Upon such action, the server generates a message to indicate to the client that the server has information waiting for the client station. (Col. 5, 20-27). The generated message may include information about the type of message that is waiting and the size of the waiting message. (Col. 6, ll. 7-17). When the mobile device user views this information, he or she can determine whether to accept the message. If the user wants the message, the user can log-in to the system and retrieve the waiting message. (Col. 6, ln. 66 to Col. 7, ln. 5).

Thus, *Harrenstien* discloses sending a notice to the user that the message is waiting, and then allowing a user to log-in and receive the message. It fails to disclose, however, any request that includes an address of the server, let alone a packet data network address which is then used for a packet data session along which a response of radio transferring capabilities is sent. Indeed, it is not even apparent how one of ordinary skill in the art could modify *Chang* based upon *Harrenstien*. In particular, *Chang* discloses a system in which a telephone is programmed over-the-air by using the OTAF function in both the initial communication to, and the response communication from, the mobile phone. If another connection, which requires a user log-in is utilized, a separate, more complex, and less efficient mechanism for over-the-air programming.

Furthermore, the reason cited by the Office for combining *Harrenstien* with *Chang* is to provide capability for the system, from not keeping the mobile station engaged in the possible

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case of an incoming call. (Office Action, p. 6). Notably, however, *Chang* includes the use of a connection to the customer service center (CSC) that already provides the operator with the means for having voice conversations at the same time the subscriber's mobile is being programmed. (Col. 3, ll. 60-67). Thus, the proffered reason for combining *Harrenstien* and *Chang* is to merely implement a feature that already exists in *Chang*. In other words, inasmuch as the only benefit and reason offered for modifying *Chang* with *Harrenstien* already exists in *Chang*, there is no reason why one of ordinary skill in the art would modify the over-the-air programming of *Chang* to include a message retrieval feature in *Harrenstien*.

2. Inherency-based Rejections

In the Office Action, the Examiner has also rejected various claims as including features inherent in *Chang*. Applicant respectfully traverses. Specifically, as noted previously and as not addressed by the Examiner, the Office provides specific requirements which must be addressed should the Office rely on an argument based on inherency. For example, "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (M.P.E.P. § 2112(IV)). Accordingly, to rely on the theory of inherency, the Office "must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (M.P.E.P. § 2112(IV)). In the Office Action, the Office makes mere assertions without any reasoning—based in fact, technical or otherwise—to reasonably support the Office's determination. Indeed, as explained below, the Office's assertions do not assert what is even claimed, and therefore fail to even provide a *prima facie* case of obviousness.

Claim 6 is instructive on this point. In particular, claim 6 depends from independent claim 1, and further recites wherein the adapting of the content of the message is based on the radio priority allocated to the wireless communication station and received in the response. For this element, the Office merely notes that radio priority is inherent in a mobile station such as mobile stations 13a-13e of *Chang*. (Office Action, p. 4).

Notably, however, claim 6 does not merely recite "wherein the mobile communication station has a radio priority," which is the feature the Office states as being inherent. Instead, the claim recites that: (1) the adapting of message content is based on a radio priority; and (2) that the radio priority of the mobile communication station is received by the server in the response.

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No assertion is even made that either such feature is inherent or otherwise disclosed in *Chang*. Further, no "basis in fact" or "technical reasoning" is even preferred to support the inherency contention. Instead, the Office Action appears merely to conclude, without any accompanied reasoning, that a feature is present, even though the feature is not fully what is claimed.

Moreover, if such a feature is inherent (namely that the mobile devices in *Chang* have a radio priority), Applicant submits that the alleged inherent characteristic, when combined with the express and implicit teachings of *Chang*, fails to disclose or suggest each and every limitation of the claimed invention. For example, *Chang* goes into great detail to describe each of various fields that can be included in response message and describe different aspects of the mobile phone's system. For example, the response can include an identification of the over the air capabilities of the mobile phone (BAND_MODE_CAP) that indicates what the phone's band and mode capabilities are, and which allows a NAM indicator block to be downloaded to the mobile. (Col. 5, ln. 61 to Col. 6, ln. 37). If the *Chang* system is already aware of the band and mode capabilities of the mobile phone, along with all of the features and service options supported by the phone, it is unclear what reason there is to further request the radio priority. Even assuming there is a reason, however, the requirement for an inherency is that it be necessary. Inasmuch as the phone can be programmed by merely knowing the features, phone version, firmware version, band/mode capabilities, and other aspects of the phone as expressly described in *Chang*, and without regard to the particular priority assigned to the phone, such a feature is not only not inherent, but not in any manner necessary for the operation of the system in *Chang*.

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. For example, dependent claim 22 recites additional features not taught nor reasonably supported by the art of record. Specifically, claim 22 recites wherein the message which has its content modified based on the radio capabilities of the wireless device is a message for display to the user. *Chang* merely discloses that when a phone is programmed the capabilities of the phone are used to determine how to program the phone over the air. *Harrenstien* discloses that when information is sent to the user, the user can

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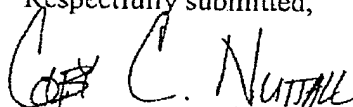
log-in and retrieve that information at the user's convenience. Thus, the combination includes only obtaining capabilities to allow over-the-air programming. The only reason one of art would have modified the system to also modify message content (when intended for the user) based on such capabilities, would be to have the present application in front of them at that time, which is clearly a hindsight-based rationale that cannot support a finding of obviousness.

Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required reason as to why one of ordinary skill in the art would have, at the time of the invention, modified the cited art in the manner officially noticed.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at (801) 533-9800.

Dated this 14th day of May, 2008.

Respectfully submitted,



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